REMARKS/ARGUMENTS

Claims 1-24 remain in the application, all of which stand rejected.

Support for the amendments to claims 1, 18 and 24 is found, at least, in paragraphs [0072]-[0075] and [0077].

1. Rejection of Claims 1-22 and 24 Under 35 USC 101

Claims 1-22 and 24 stand rejected under 35 USC 101 as being drawn to non-statutory subject matter. However, the "New Interim Patent Subject Matter Eligibility Examination Instructions", issued August 24, 2009, state in Section II.A.(c) that:

> . . .a claim to a non-transitory, tangible computer readable medium per se that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be patent-eligible subject matter. Adding additional claim limitations to the medium, such as executable instructions or stored data, to such a statutory eligible claim would not render the medium non-statutory, so long as the claim as a whole has a real world use and the medium does not cover substantially all practical uses of a judicial exception. The claim as a whole remains a tangible embodiment and qualifies as a manufacture.. . .

Claim 1 is directed to "A computer readable medium having an electrically, magnetically or optically stored computer program, the computer program having instructions that, when executed by a processor of a computer system, provide a test development tool. . .". The above-noted patent subject matter eligibility examination instructions, and included example, clearly indicate that claim 1 recites patent-eligible subject matter, because a "computer readable medium" having an "electrically, magnetically or optically stored computer program" possesses a structural limitation (i.e., a medium for storing). The fact that the medium stores a computer program does not pull the claim outside the scope of patent-eligible subject matter. Furthermore, the computer program that is stored on the medium accesses and defines test programs for

programming "automated test equipment" to test "integrated circuit devices". Thus, the medium and computer program each have a "practical application" - i.e., the programming of automated test equipment to test integrated circuit devices.

Claims 18 and 24 are believed to recite patent-eligible subject matter for reasons similar to why claim 1 is believed to recite patent-eligible subject matter.

The remainder of claims 1-22 and 24 depend from claim 1 or 18. Thus, all of claims 1-22 and 24 are believed to recite patent-eligible subject matter.

Of note, the amendments to claims 1, 18 and 24 clearly prevent these claims from being read on a "carrier wave" or the like, as a "carrier wave" or propagation medium is not capable of 'storing' a computer program.

2. Rejection of Claims 1-10, 12-15, 18, 19 and 21-24 Under 35 USC 103(a)

Claims 1-10, 12-15, 18, 19 and 21-24 stand rejected under 35 USC 103(a) as being unpatentable over Gray et al. (7,290,174; hereinafter "Gray") in view of Hamameh et al. (US 5,864,660; hereinafter "Hamameh"). Applicants respectfully disagree.

Claim 1 recites "test development program code for *accessing first and second pre-established test programs, each of said first and second pre-established test programs having been previously established for respective first and second pre-existing integrated circuit devices, and said first and second pre-established test programs each having respective first and second sets of subtest code portions*". In contrast, Gray only discloses the generation of test instruction sequences from "fragments". Gray does not access pre-established test programs. Nor does Gray evaluate portions of pre-established test programs to determine whether those portions may be combined when forming "a new test program" that concurrently tests first and second pre-existing integrated circuit devices.

The Examiner asserts on page 5 of his Final Office Action that Gray *does* teach the test development code of applicants' claim 1, because the "test fragments" mentioned in

Gray's col. 4, lines 26-34, are "pre existing programs". However, Gray does not call the "test fragments" pre existing programs. Instead, Gray indicates that the test fragments are "binary representations of various instructions supported by a processor". As an example, Gray provides the following exemplary test fragment (or instruction):

logicRand / rC / "," / rA / "," / rB

Applicants assert that this appears to be a processor-level instruction, and one of ordinary skill in the art would not deem the above instruction to be a "pre-established test program". It is certainly not a pre-established test program for testing an integrated circuit device.

Although Hamameh discloses the compilation of test codes for "integration testing" (i.e., testing to ensure that different components work with one another), Hamameh does not disclose "test development program code *for evaluating the first and second sets of subtest code portions and determining whether any respective subtest code portions of said first and second sets of subtest code portions have features allowing for combination in a new test program,* said test development program code for the evaluating and determining steps providing at least one output result thereof". Rather, Hamameh pre-defines integration points between components (col. 4, line 32 - col. 5, line 18) and then pre-generates different test codes for the different components that may be coupled to one another via one of the integration points (col. 5, line 27 - col. 6, line 28). Thus, when two components are combined it is known that the test codes for two elements can be combined; and no sort of *evaluation* is needed to determine whether the test codes can be combined. Also, and because Hamameh pre-generates test codes that can be combined, there is no reason that one of ordinary skill in the art would have found it useful to introduce such an analysis to Hamameh's system.

For at least the above reasons, claim 1 is believed to be allowable.

Claims 2-10 and 12-15 are believed to be allowable, at least, because they depend from claim 1.

Claims 18, 19 and 21-24 are believed to be allowable, at least, for reasons similar to why claim 1 is believed to be allowable.

3. Conclusion

In light of the amendments and remarks provided herein, applicants respectfully request the issuance of a Notice of Allowance.

Respectfully submitted,
HOLLAND & HART, LLP

By: _/Gregory W. Osterloth/_____
Gregory W. Osterloth
Reg. No. 36,232
Tel: (303) 295-8205